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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,547	06/29/2001	Jonathan Sharp	042933/308761	4444
826	7590	04/12/2006	EXAMINER	
ALSTON & BIRD LLP BANK OF AMERICA PLAZA 101 SOUTH TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280-4000			LESNIEWSKI, VICTOR D	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/893,547	SHARP ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor Lesniewski	2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/3/2006</u>  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. The amendment filed 1/30/2006 has been placed of record in the file.
2. No claims have been amended.
3. Claims 23-27 have been added.
4. Claims 15-27 are now pending.
5. The applicant's arguments with respect to claims 15-22 have been fully considered but they are not persuasive. A detailed discussion is set forth below.

***Continued Examination Under 37 CFR 1.114***

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. The applicant's submission filed on 1/30/2006 has been entered.

***Information Disclosure Statement***

7. The IDS filed 3/3/2006 has been considered.

***Claim Rejections - 35 USC § 102***

8. Claims 15-22 remain rejected under 35 U.S.C. 102(e) as being anticipated by Peng (U.S. Patent Number 6,816,944) as presented in the previous action dated 8/26/2005.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng.

11. Concerning claims 23 and 26, Peng did not explicitly state determining if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content. However, Peng does use a transaction manager in order to track the progress and status of each transaction. Peng also bills the user for certain transactions. It is clear that when a service provider bills a user for some network activity or transaction, it would be in response to the actual activity or transaction (i.e. a service has been rendered). Thus, it is also clear that the system would make some determination that the transaction was completed successfully or the service rendered before billing the user. In view of the foregoing, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Peng by adding the ability to determine if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content. Normal network service providers would not bill a user for a service without first rendering the service.

12. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a server are rejected under the same rationale applied to the described claim.

13. Thereby, Peng discloses:

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- <Claims 23 and 26>

A method for downloading adaptation data from a server to a portable radio communication device, comprising: allowing at least selective access to the adaptation data on a memory of the server for download to the portable radio communication device (column 5, lines 17-37 and column 15, lines 3-26); downloading the adaptation data from the memory of the server to the portable radio communication device (column 15, lines 3-26); applying the adaptation data to electronic content stored on the portable radio communication device so as to modify the electronic content to provide adapted electronic content (column 15, lines 20-26); generating data based on the applying of the adaptation data to the electronic content (column 7, lines 38-46); and if the generated data includes an indication that the adaptation data has been successfully applied to the electronic content (obviousness as discussed above in paragraph 11), computing remuneration data related to the electronic content and the adaptation data based on the generated data (column 7, lines 44-46).

- <Claims 24 and 27>

A method according to claim 23, wherein the electronic content comprises original games content and the adaptation data comprises supplementary software for modifying the original games content (column 1, lines 35-43 and column 15, lines 15-20).

- <Claim 25>

A method according to claim 23, further comprising, before downloading the adaptation data, determining whether the portable radio communication device is entitled to access to the adaptation data, and wherein the adaptation is downloaded to the portable radio

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communication device only if the portable radio communication device is entitled to access the adaptation data (column 7, lines 46-53).

Since Peng discloses all of the above limitations, claims 23-27 are rejected.

### ***Response to Arguments***

14. In the remarks, the applicant has argued:

- <Argument 1>

Peng does not disclose the features of claim 15 because he does not disclose “computing remuneration data related to the electronic content and the adaptation data based on the generated data” as recited in claim 15.

15. In response to argument 1, Peng does disclose the remuneration data as recited in claim

15. The previous line citation, column 7, lines 44-46, clearly states that the system computes a detailed record of each user’s billable activities. This detailed record satisfies the limitation of remuneration data as stated in the claim. In support of the argument, the applicant has stated that “The present invention actually performs computations to determine a charge to be levied.”

However, this is not a limitation of the claim. The applicant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

16. In addition, the applicant has argued that claims rejected under 35 U.S.C. 102 and 35 U.S.C. 103, but not explicitly discussed, are allowable based on the above arguments. Thus, claims disclosing similar limitations to the discussed claims and related dependent claims remain rejected under the same reasoning as presented above.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor Lesniewski whose telephone number is 571-272-3987.


The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571-272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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